

REMARKS

Claims 1-30 are currently pending in this application. In the Office Action mailed February 17, 2005 (the "Office Action"), claims 1-30 were rejected based on alleged anticipation and/or obviousness. Applicant respectfully requests reconsideration of the claims as filed in light of the following remarks.

Claim Rejections – 35 USC § 102(b) - Luraschi

Claims 1, 2 10, 11, 16 and 17 were rejected under 35 USC § 102(b) as being anticipated based on French Patent 2,814,445 to Luraschi (the "Luraschi reference"). Applicant respectfully traverses this rejection as set forth below.

In order for a reference to anticipate the present claimed invention under 35 USC 102(b), it must be shown that each and every element of the claim can be found in the reference. If it can be shown that one element of the claim is missing or not met by the cited reference, the rejection must be withdrawn as inappropriate.

Claim 1 recites a system for providing fresh potatoes for consumption. The system comprises a container of suitable construction to be placed in and withstand a cooking environment capable of cooking fresh potatoes, and one or more fresh potatoes placed within the container.

Claim 16 recites a method of providing fresh potatoes for consumption, comprising the steps of: (a) packaging one or more fresh potatoes within a container of suitable construction to be placed in and withstand a cooking environment capable of cooking fresh potatoes; and (b) distributing the container to a consumer.

The Luraschi reference fails to disclose each and every element of the invention as set forth in independent claims 1 and 16. More particularly, Luraschi does not disclose the claimed feature of “one or more *fresh* potatoes placed within a container” as set forth in claim 1, nor the step of “packaging one or more *fresh* potatoes within a container of suitable construction to be placed in and withstand a cooking environment capable of cooking fresh potatoes” as set forth in claim 1. Quite the contrary, as set forth in the Abstract, the Luraschi reference specifically discloses that “The potatoes are treated chemically by thermo-nebulisation to prevent them from germinating, and after packing are covered by a welded film layer.”

A fundamental aspect of the present invention, as evidenced throughout, is the claimed feature of providing one or more *fresh* potatoes within a container of suitable construction to be placed in and withstand a cooking environment capable of cooking them. As set forth on page 7, lines 10-13, the fresh potatoes of the present invention are only washed prior to being packaged. In other words, the potatoes of the present invention are not processed or treated in any manner, such as the thermo-nebulisation as taught in the Luraschi reference. The potatoes of the present invention boast an all

natural, truly fresh condition without the ill-effects and/or negative perceptions about chemical treatments or processing.

Because the Luraschi reference is silent to at least one element of claim 1 and claim 16, it is respectfully requested that the rejection in the Office Action be withdrawn. Claims 1 and 16 are believed to be in proper condition for allowance and a determination of such is hereby respectfully requested.

Claims 2 and 10-11, being dependent upon and further limiting independent claim 1, should be allowable for the reasons set forth in support of the allowability of claim 1. Claim 17, being dependent upon and further limiting independent claim 16, should be allowable for the reasons set forth in support of the allowability of claim 16.

Claim Rejections – 35 USC § 103(a) – Luraschi in view of Fritz

Claims 3, 4, 18 and 19 were rejected under 35 USC § 103(a) as being obvious over the Luraschi reference in view of US Patent No. 5,607,709 to Fritz (the “Fritz reference”). Applicant respectfully traverses this rejection as set forth below.

To establish a *prima facie* case of obviousness under 35 USC § 103(a) in view of a reference or combination of references, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of

success. Third, the prior art reference(s) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Claims 3-4 are dependent upon independent claim 1 and claims 18-19 are dependent upon independent claim 16. As noted above, the Luraschi is silent with regard to the claimed feature of “one or more *fresh* potatoes placed within a container” as set forth in claim 1, as well as the step of “packaging one or more *fresh* potatoes within a container of suitable construction to be placed in and withstand a cooking environment capable of cooking fresh potatoes” as set forth in claim 16. While the Fritz reference does disclose providing cooking instructions on a microwavable container, it does not appear to disclose any teaching, suggestion or motivation about “one or more fresh potatoes” within such a container.

Given the voids in both the Luraschi and Fritz references, one of ordinary skill in the art would not have consulted the cited references and, even if so, would not have been led to the present invention as set forth in claims 3-4 and 18-19. Applicant respectfully requests a withdrawal of a finding of obviousness with respect to claims 3-4 and claims 18-19. Applicant further believes claims 3-4 and 18-19 are in proper condition for allowance and respectfully requests an indication of the same.

Claim Rejections – 35 USC § 103(a) – Luraschi in view of Pickard

Claims 5-15 and 20-30 were rejected under 35 USC § 103(a) as being obvious over the Luraschi reference in view of US Patent No. 5,220,909 to Pickard (the “Pickard reference”). Applicant respectfully traverses this rejection as set forth below.

To establish a *prima facie* case of obviousness under 35 USC § 103(a) in view of a reference or combination of references, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference(s) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Claims 5-15 are dependent upon independent claim 1 and claims 20-30 are dependent upon independent claim 16. As noted above, the Luraschi is silent with regard to the claimed feature of “one or more *fresh* potatoes placed within a container” as set forth in claim 1, as well as the step of “packaging one or more *fresh* potatoes within a container of suitable construction to be placed in and withstand a cooking environment capable of cooking fresh potatoes” as set forth in claim 16. While the Pickard reference does disclosure providing condiments and eating utensils within a microwavable

container, it does not appear to disclose any teaching, suggestion or motivation about
“one or more fresh potatoes” within such a container.

Given the voids in both the Luraschi and Pickard references, one of ordinary skill in the art would not have consulted the cited references and, even if so, would not have been led to the present invention as set forth in claims 5-15 and 20-30. Applicant respectfully requests a withdrawal of a finding of obviousness with respect to claims 5-15 and claims 20-30. Applicant further believes claims 5-15 and 20-30 are in proper condition for allowance and respectfully requests an indication of the same.

CONCLUSION

The foregoing remarks have been submitted to place the present application in condition for allowance. Favorable reconsideration and allowance of the claims in this application is respectfully requested. In the event that there are any questions concerning this response or the application in general, the Examiner is cordially invited to telephone the undersigned attorney so that prosecution may be expedited.

Respectfully submitted,
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